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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,279	08/26/1999	BRIAN K. WHARTON	214014600004	6359

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/383,279

Applicant(s)

WHARTON, BRIAN K.

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's responses to Office Action mailed 3/22/2002. Amendment A response received 6/20/2003, was returned to the applicant as none response. Amendment B was entered on 10/24/2003, which was a response to the Office action for non-responsive amendment mailed 10/7/2003, which was received on 10/24/2003. The examiner will combine responses to amendments A and B in this action since amendment B does not include arguments for claims 15-18.

Acknowledgement is made to the cancellation of claims 1-14, and the addition of new claims 19-32. The amendments and argument of amendments A and B have been carefully considered, but were found not to be persuasive. Therefore, the previous rejection for claims 15-18 is restated and a rejection of new claims 19-33 is provided below:

Specification

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "16" has been used to designate both "payment proxy system" and "runtime payment logic" and "payment proxy" (see pages 22 and 24). Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the runtime payment

logic must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Chelliah et al (5,710,887).

In response to claim 15, Chelliah discloses a method of conducting E-Commerce, comprising the steps of:

- (A) connecting to an E-Commerce portal (**Item 26**);
- (B) linking from the E-Commerce portal to a vendor commerce system associated with the E-Commerce portal (**Item 22**);

(C) browsing a local catalog of products stored at the vendor commerce system and selecting a particular product for purchase. Chelliah teaches a catalog and shopping cart (col 26, lines 35-53) and the ability to create combinations to internalize the process based on the customers needs (col 28, lines 20-34). Therefore, the catalog and shopping basket "cart" can be located at the vendors commerce system of the central commerce system if deemed necessary by the customer (vendor);

(D) transmitting a transaction packet from the vendor commerce system to a common transaction processing system via the Internet, and storing the transaction packet in a global shopping basket (see above and FIG 8, col 25, lines 17-67, col 26, lines 1-67 and col 27, lines 1-21);

(E) returning to step (A) and repeating steps (B), (C) and (D) until no additional products are to be purchased (col. 15, lines 6-23);

(F) segmenting the transaction packet information stored in the global shopping basket and aggregating individual product order items by vendor (col. 27, lines 51-59);

(G) processing the individual product order items for each vendor at the transaction processing system by communicating transaction information between the transaction processing system and a plurality of back-end processing systems (col 1, lines 28-47).

In response to claim 16, Chelliah teaches wherein the processing step (G), further comprises the steps of.

(G)(1) querying a vendor database to obtain vendor-specific processing rules used by the transaction processing system to process the transaction order items for a particular vendor (col. 15, lines 6-23); and

(G)(2) querying a customer database to obtain customer-specific processing rules used by the transaction processing system to process the transaction order items for a particular customer (col. 4, lines 49-59).

In response to claim 17, Chelliah discloses a payment proxy system for use with an online transaction processor, comprising: a payment proxy interface for communicating information to and from the transaction processor; runtime payment logic for determining, in real-time, how to process a particular transaction request transmitted to the payment proxy from the transaction processor; and a plurality of payment connection modules coupled to the runtime payment logic for interfacing the transaction request to one of a plurality of payment verification systems (**FIGs 8, 8a, 8b**, col. 15, lines 43, col. 16, lines 1-67, col. 17, lines 1-45).

In response to claim 18, Chelliah discloses an E-Commerce framework, comprising:

a plurality of vendor commerce systems linked to a common E-Commerce portal (**FIG 1**),

wherein each vendor commerce system includes a local product catalog and a local shopping basket (See response to claim 15); a transaction processor linked to the

E-Commerce portal via a computer network (**FIG 2**), the transaction processor having a global shopping basket and an interface for communicating transaction information between the local shopping baskets of the vendor commerce systems and the global shopping basket of the transaction processor (See response to claims 15 and 16); a plurality of payment verification systems for authenticating transaction requests generated by the transaction processor when a customer of the framework engages a global checkout function (FIGs 8, 8a, 8b, col. 15, lines 43, col. 16, lines 1-67, col. 17, lines 1-45); and a payment proxy system coupled between the transaction processor and the plurality of payment verification systems for transmitting transaction requests generated by the transaction processor to the appropriate payment verification system (col 6, lines 13-25 and FIG 2).

Claim Rejections - 35 USC § 103

Claims 19-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chelliah and further in view of Official Notice.

In regards to claims 19-33, Chelliah teaches all the claimed elements except as follows:

Chelliah discloses the claimed invention except for certain locations and various direct couplings of features. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate these features and couplings as shown in the instant claims, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Chelliah teaches storing a list of purchases and associated information corresponding to a plurality of Suppliers selling products, but does not specifically mention that a vendor may be identified for each selection. It was old and well known in the art at the time of the invention to identify a vendor in association with a purchased item. It would have been obvious to a person of ordinary skill in the art to include in Chelliah identifying the vendor associated with a particular selection, because supplying this information to the customer will allow the customer to make a more informed decision.

Chelliah teaches processing orders and storing information in a predetermined format, but does not specifically mention that the predetermined format features of the instant claims. It was old and well known in the art at the time of the invention to place transaction packets in a predetermined format such as stated in the instant claims. It would have been obvious to a person of ordinary skill in the art to include in Chelliah the formatting features of the instant claims, because as stated in Chelliah the system "...provides flexibility at the individual store level while supporting simultaneous transactions among a plurality of electronic stores, by defining a family of elementary Commerce Subsystems 16 and 18 necessary to support the various elements of electronic commerce, and allowing each store to select a particular combination of subsystems interconnected in a particular pattern to suit its particular operating style." Therefore, to accomplish this, it is important to predetermine the format to assure

speedy processing of the information amongst the various subsystems. (See also, col 8, lines 50-60)

Chelliah teaches transaction processing of a plurality of payment methods (col 8, lines 50-67) but does not specifically mention the use of runtime logic to determine how to best process the transaction. As stated in the specification of the instant application, *"The runtime payment logic 62 can take many forms and can operate many functions, in addition to simply determining where to route the particular transaction request. For example, various business rules particular to a certain merchant could be executed by the runtime payment logic. These business rules may take the form of scripting information that is stored in the associated merchant database 18."* Considering this definition it was old and well known in the art at the time of the invention to apply scripting rules to determine how a transaction would be processed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include scripting rules in the system of Chelliah as taught by the instant claims, because this would assure that the payment was processed properly (see FIG 8B).

Response to Arguments

Applicant's arguments filed 6/20/2003 (Amendment (A) paper#10) and 10/24/2003 (Amendment B, paper#15) have been fully considered but they are not persuasive.

Applicant argues the allowability of claims 1-14. However since these claims have been canceled, the arguments with respect to claims 1-14 are moot.

In regards to claim 15, applicant argues that the cited col and lines of Chelliah "discloses a "Sales Representative Program Object for Multiple Stores" and "maintaining a list of all items selected by the customer", but does not teach nor enable the processing of such a list." The examiner disagrees and points the applicant's attention to col 3, lines 46-55 and the deselecting of an item from a list (shopping cart) and the recalculation of the total price (processing of the list),

In regards to claim 16, applicant argues that Chelliah does not disclose a database containing rules used by a transaction processing system to process transaction order items specific to vendors and customers. The examiner disagrees and points the applicant's attention once again to col 15, lines 6-23. Note that it is "the stores" database that holds "pricing rules" specific to the stores offered coupon. Furthermore, once again the examiner cites col 4, lines 49-60, which states "means for accessing the customer information database" which include "...forms of payment available to the customer" a rule being, use the payment available in the database.

In regards to claim 17, applicant argues that the reference does not disclose a payment proxy interface for communicating with the transaction processor, as a

participant program object serves a different purpose than a transaction processor and the two should not be equated. The examiner is unable to ascertain the applicant's argument since the applicant does not define to the examiner the "different purposes" and why "the two should not be equated". However, FIG 8A, clearly shows a payment proxy interface (payment handler, item 183,184 that sends back pass or fail message). Applicant also argues that the system of Chelliah appears to be monolithic and does not teach a plurality of verification systems, however, at least figure 8A shows different forms of payment being processed by the payment verification system of Chelliah.

In regards to claim 18, applicant argues that Chelliah does not teach the use of both local shopping carts and global shopping carts. The examiner disagrees. Microsoft Computer Dictionary defines shopping cart as "a file in which an online customer stores information on potential purchases until ready to order". Clearly this is taught by Chelliah's list from various stores (global), that can be amended to present a finalized order upon checkout, this could also be done for one store (local) if so desired. Also, the applicant is directed to col 14, lines 64-67 which stated that the list is "...analogous to a shopper placing an item in a shopping cart in preparation for purchase." In regards to the transaction processor, the examiner further directs the applicant's attention to col 13 through col 23, with particular attention to col 14 "Transaction Processing".

In regards to claims 19-33, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

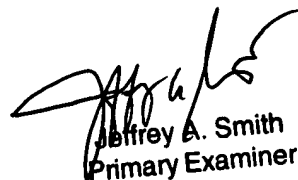
(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner



Jeffrey A. Smith
Primary Examiner